

## REMARKS

By this response, Applicants add new claim 29 to protect additional aspects of the invention and amend claim 1 to more appropriately define the instant invention. The amendments herein do not in any way reflect a concession on the part of Applicants that the prior art of record, alone or in any combination, taught or suggested the invention as claimed prior to such amendments.

In the Office Action dated November 5, 2002, the Examiner rejected claims 1-7 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,770,841 to *Moed et al.*, ("Moed") in view of U.S. Patent No. 5,769,640 to *Jacobus et al.*, ("Jacobus"). Claims 1-7, and 29 are pending. Applicants traverse the Examiner's rejection as discussed below.

### Rejection of claims 1-7 under 35 U.S.C. § 103(a)

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), each of three requirements must be met. First, the references, taken alone or in combination, must teach or suggest each and every element recited in the claims. (See M.P.E.P. § 2143.03 (8th ed. 2001).) Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of these requirements must "be found in the prior art, and not be based on applicant's disclosure." (M.P.E.P. § 2143 (8th ed. 2001) emphasis added.)

The Examiner alleges that *Moed* discloses substantially the elements recited in claim 1. Stating that *Moed*'s "imaging system (12) [includes] a height sensor (26)...," the Examiner alleges that *Moed* teaches the object dimensioning system recited in claim 1 (Office Action, page 3). The Examiner further alleges that *Moed*'s "camera (16) serves as an image capture

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
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system" (Office Action, page 3). Moreover, according to the Examiner, "*Moed* fairly suggest[s] that the [images] of objects [are time-dependent]...and the object dimension information, identification information, and electronic images each have time-stamp information" (Office Action, page 3).

Additionally, the Examiner avers that *Jacobus* teaches recording a "data item...with a time-stamp wherein the time-stamp is correlated with each data item" (Office Action, page 3). According to the Examiner, it would have been obvious to a skilled artisan "to incorporate the teachings of *Jacobus* [with] the teachings of *Moed*...to provide an improved...management means..." (Office Action, page 3).

Applicants submit that the Examiner's rejection is ambiguous. The Examiner first alleges, without citing any portion of the reference, that *Moed* "fairly" suggests time-dependent images (which appears to be directed at claim 1), and that "the object dimension information, identification information, and electronic images each have time-stamp information" (which appears directed at claim 3). The Examiner proceeds by alleging that *Jacobus* teaches recording data items with time-stamps and that it would have been obvious to combine *Jacobus* with *Moed*. Thus, the rejection is unclear as to (1) what the Examiner contends *Moed* teaches or suggests; and (2) how the Examiner is applying *Jacobus* to Applicants' claims and if, in fact, the Examiner is applying *Jacobus* to claim 1. Notwithstanding these ambiguities, Applicants, to the extent possible, traverse the rejection and provide the following arguments.

*Moed* describes a system for reading and decoding bar codes from packages and verifying the accuracy of destination addresses. *Moed*'s system includes a camera 16 to "capture an image of the top surface of the package..." and a label decoding system 14 that "locates and decodes machine readable package identification data and destination address data contained in

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
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the image" (col. 5, lines 15-30). In addition, as the Examiner mentions, *Moed*'s imaging system 12 includes a package height sensor 26, which is "a commercially available light curtain...used to [determine] the height of the package before it passes beneath...camera 16" (col. 5, lines 61-67).

By contrast, claim 1 recites a combination of elements including:

an object dimensioning system for producing time-dependent dimension information for each of the objects as each object moves relative to the dimensioning system...and

an image capture system for producing time-dependent images of the objects.

A *prima facie* case of obviousness cannot be established using *Moed* and *Jacobus*. To begin with, *Moed* fails to teach or suggest the object dimensioning system recited in claim 1. *Moed*'s package height sensor 26 is inconsistent with Applicants' claimed object dimensioning system. The former merely determines "the height of the package before it passes beneath...camera 16," while the latter produces time-dependent dimension information for an object, as it moves relative to the dimensioning system. There is no indication from *Moed* that height sensor 26 or any other element of imaging system 12 produces time-dependent dimension information. Thus, *Moed* fails to teach or suggest the object dimensioning system recited in claim 1. And for at least this reason, a *prima facie* case of obviousness cannot be established using *Moed*.

With regard to *Jacobus*, Applicants remind the Examiner of the following requirements set forth in MPEP § 2141.01(a):

"In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re*

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
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*Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992).

Applicants submit that *Jacobus* is nonanalogous art and therefore an improper reference against the present application under 35 U.S.C. § 103(a). *Jacobus* is not in the same field of endeavor as Applicants' application. *Jacobus* relates to a system for simulating medical procedures, which is dissimilar to and incongruous with the application under examination. Further, *Jacobus* is not reasonably pertinent to the particular problem that the present application addresses. That is to say, *Jacobus* would not logically have commended itself to an inventor's attention in considering the problem addressed by the present application. Accordingly, *Jacobus* is to be regarded as nonanalogous art and should not be used as a reference against the present application under 35 U.S.C. § 103(a), and any subsequent rejection of the claims by the Examiner should not be made final.

However, even if *Jacobus* were properly applied against the present application (which Applicants dispute), *Jacobus* fails to cure *Moed*'s deficiencies. *Jacobus* does not teach or suggest an object dimensioning system for producing time-dependent dimension information, as recited in claim 1. Thus, a *prima facie* case of obviousness cannot be established using *Moed*, *Jacobus*, or any combination thereof. Claim 1 is therefore patentable over the applied references.

In addition, while alleging that "*Moed* fairly suggest[s] that the [images] of objects are [time-dependant]...," the Examiner fails to cite any portion of the reference whatsoever to substantiate the allegation. Indeed, Applicants submit that *Moed* fails to suggest "an image capture system for producing time-dependent images of the objects," as recited in claim 1.

To the extent the Examiner is alleging that *Jacobus* could cure such a deficiency of *Moed*, Applicants disagree based the following remarks: To begin with, as stated above,

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
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Applicants deem *Jacobus* nonanalogous art and therefore an improper reference against the present application under 35 U.S.C. § 103(a). But even if *Jacobus* could properly be applied against the present application (Applicants disputing that notion), and assuming that *Moed*'s deficiencies could be found in *Jacobus* (Applicants disputing that notion), a *prima facie* case of obviousness cannot be established via the supposed combination. There is absolutely no suggestion or motivation to combine *Moed*'s system for reading package information with *Jacobus*' unrelated system for simulating actual medical procedures. Applicants submit that no objective reason exists to combine the cited references as purported by the Examiner. As MPEP § 2143.01 provides, the mere fact that references can be combined is insufficient to establish a *prima facie* case of obviousness. The Examiner fails to provide any rationale as to why one would combine the incongruous references other than to meet the terms of Applicants' claims. The Examiner is improperly attempting to use Applicants' disclosure to satisfy the requirements set forth in M.P.E.P. § 2143. The Examiner alleges that combining the cited references would "provide an improved...management means for accessing/retrieving information of the packages...using the time stamp" and that the supposed combination would yield a "means for tracking...each and every package using the barcode and the time-stamp...associated with the particular package." However, even if such features could be realized by combining *Jacobus* and *Moed* (to which Applicants do not acquiesce) one of ordinary skill in the art would neither be motivated nor equipped to perform such a combination absent Applicants' disclosure. For at least these reasons, a *prima facie* case of obviousness cannot be established using the cited references. Accordingly, Applicants deem claim 1 patentable.

With regard to dependent claim 3, the Examiner alleges that "*Moed* fairly suggest[s] that the... object dimension information, identification information, and electronic images each have

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
[www.finnegan.com](http://www.finnegan.com)

time stamp information” (Office Action, page 3). The Examiner also alleges that *Jacobus* teaches recording a “data item with a time-stamp wherein the time-stamp is correlated with each data item” (Office Action, page 3).

Applicants submit that *Moed* fails to suggest the features recited in dependent claim 3. In fact, while alleging that *Moed* suggests the time-stamp information recited in claim 3, the Examiner fails to cite any portion of the reference whatsoever to substantiate the allegation. Moreover, even if *Jacobus* could cure *Moed*’s deficiency (to which Applicants do not acquiesce), a *prima facie* case of obviousness cannot be established using *Moed* and *Jacobus* for at least the reasons presented above in connection with claim 1.

For at least the above-mentioned reasons, claim 3 is patentable. Moreover, claim 3 is patentable by virtue of its dependence from allowable base claim 1.

Claims 2 and 4-7 depend from allowable base claim 1 and are patentable at least by virtue of such dependency. Accordingly, Applicants request withdrawal of the rejection under 35 U.S.C. § 103(a) and the timely allowance of claims 1-7.

#### **Newly submitted claim**

Newly submitted independent claim 29 recites a combination including:

at least one processor for associating time values with the positional information and computing models of the objects using the positional information and the dimension information.

Neither *Moed* nor *Jacobus*, nor any combination thereof, teaches or suggests at least the above element recited in new claim 29. For at least this reason, new claim 29 is patentable.

Moreover, Applicants deem new claim 29 patentable for at least the reasons presented above in connection with claim 1. Applicants therefore request the timely allowance of the new claim.

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
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**Conclusion**

In view of the foregoing, Applicant respectfully requests the reconsideration and reexamination of this application and the timely allowance of the pending claims.

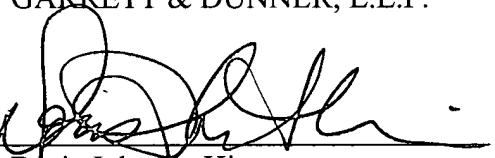
Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

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By:

  
Doris Johnson Hines  
Reg. No. 34,629

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
[www.finnegan.com](http://www.finnegan.com)

## APPENDIX OF AMENDMENTS TO THE CLAIMS

1. (Amended) A system for capturing information about objects moving relative to the system comprising:
  - an object dimensioning system for producing [object] time-dependent dimension information for each of the objects as each object moves relative to the dimensioning system;
  - an object identification system for producing object identification information for the objects; and
  - an image capture system for producing time-dependent images of the objects.

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

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